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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,113	02/25/2002	Paul Trpkovski	44046.103.130.21.2	6810
22859	7590	03/10/2005		
EXAMINER				
CULBERT, ROBERTS P				
ART UNIT		PAPER NUMBER		
		1763		
DATE MAILED: 03/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/084,113	TRPKOVSKI, PAUL
	<b>Examiner</b>	<b>Art Unit</b>
	Roberts Culbert	1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 2/18/05.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 5-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 5-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/18/05 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 2/18/05 have been fully considered but they are not persuasive.

Applicant has argued that the rejection of claims 5-7 under U.S.C 103(a) should be withdrawn since DeRosset does not teach the step of detecting the corner of the workpiece.

The argument is not persuasive to overcome the rejection because the rejection of the claimed limitation is based on DeRosset in view of the admitted prior art of applicant's disclosure.

Applicant has argued that that the rejection of claims 8, 9, 14 and 15 under U.S.C 103(a) should be withdrawn since DeRosset does not teach the step of finding the first edge and second edge of the workpiece.

The argument is not persuasive to overcome the rejection because DeRosset inherently teaches the claimed limitation as broadly recited by applicant. The position of the workpiece (and therefore the edges of the workpiece) must be visually or mechanically located (detected) in order to place indicia in a desired location on the workpiece.

Applicant has argued that that the rejection of claims 10-13 under U.S.C 102(b) should be withdrawn since DeRosset does not teach the step of obtaining the dimensions of a workpiece as recited in claim 10.

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The argument is not persuasive to overcome the rejection because DeRosset inherently teaches the claimed limitation as broadly recited by applicant.

The dimensions of the workpiece must be visually or mechanically located (obtained) in order to place indicia in a desired location on the workpiece using x and y coordinates as disclosed in DeRosset.

Applicant has argued that that the rejection of claims 16-27 under U.S.C 103(a) should be withdrawn since DeRosset does not teach the step of testing the workpiece to determine window specification data.

The argument is not persuasive to overcome the rejection because the admitted prior art of applicant's disclosure teaches the claimed limitation as recited by applicant.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,298,717 to DeRosset Jr.**

Referring to the specification and figures, DeRosset Jr. teaches a computerized method of indicia placement on a planar surface, comprising the steps of: providing a workpiece having a planar surface; providing an indicia image; obtaining the dimensions of the planar surface; inputting an approximate desired indicia location and a desired orientation; calculating an optimal indicia location on the planar surface according to the desired indicia location; effecting the movement of an indicia imparting device to the optimal indicia location on the planar surface; and imparting the indicia at the optimal indicia location on the planar surface, where the step of imparting the indicia comprises the steps of placing a laser emitting device to be adjacent the planar surface and aimed perpendicularly to said surface, and emitting

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light from the laser in a pattern to impart the indicia image, where the step of emitting light from the laser in a pattern to impart the indicia is effected by a picture-imparting laser and the step of emitting light from the laser in a pattern is effected according to a computerized image file.

Note that although DeRosset does not explicitly recite obtaining the dimensions of the workpiece, the dimensions of the workpiece must be visually or mechanically located (obtained) in order to place indicia in a desired location on the workpiece using x and y coordinates as disclosed in DeRosset. Therefore, the limitation is considered inherent in the method of DeRosset as broadly claimed by applicant.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,298,717 to DeRosset Jr. in view of U.S. Patent 6,060,157 to LaPerre et al. and in further view of the admitted prior art.**

Regarding Claim 5, DeRosset Jr. teaches a method and apparatus for etching indicia on a glass surface such as window glass using a laser. The method of DeRosset Jr. comprises providing a laser beam etcher capable of etching an image in the planar workpiece positioning said planar workpiece perpendicularly to the aim of said etcher; calculating an optimal indicia location according to established parameters; moving said laser beam etcher adjacent said optimal indicia location; providing image data; providing orientation data; transmitting said image data and said orientation data to said laser beam etcher; and imparting the indicia to the workpiece using the laser.

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DeRosset Jr. does not teach that the orientation data indicates that the etched indicia will comprise a mirrored image so that the etched indicia comprise a mirrored image readable through the workpiece.

LaPerre et al. teaches that it is conventional in the art of etching indicia on a transparent article such as window glass to etch the image as a mirrored image readable through the workpiece. (Col. 1, Lines 34-54) It would have been obvious to one of ordinary skill in the art at the time of invention to etch the window glass indicia of DeRosset Jr. in the conventional manner.

Regarding Claims 6, and 7, DeRosset Jr. teaches that image data is transmitted to a computer, which converts the image data into a control signal and transmits the control signal to the laser. It is inherent in the method of DeRosset Jr. that the data also contains orientation data in order to provide a properly oriented image. It would have been obvious to one of ordinary skill in the art at the time of invention to transmit the orientation and image data either as separate data elements or as incorporated image data in order to provide a properly oriented image.

DeRosset Jr. does not explicitly teach placing the indicia proximate a corner of said workpiece.

However, the admitted prior art teaches that it is known in the art of etching information on window glass to place indicia in the bottom corner of the glass. It would have been obvious to one of ordinary skill in the art at the time of invention to use the etching method and apparatus of DeRosset Jr. to etch the bottom corner of window glass as described in the admitted prior art as DeRosset Jr. teaches a method that is particularly well suited to forming images in window glass in a particular location using a laser. Placing indicia in the corner of the glass would inherently involve detecting the corner of the workpiece in order to input the desired location of the indicia using x and y coordinates.

**Claims 8, 9 and 14-27, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,298,717 to DeRosset Jr. in view of the admitted prior art.**

Referring to the specification and figures, DeRosset Jr. teaches a computerized method of imparting an indicia to a planar surface, comprising the steps of: providing an etcher capable of etching an indicia in the planar workpiece media; providing a subject of the planar workpiece media having a first

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edge and a second edge; determining a desired indicia location proximate said workpiece, said location being at an intersection of a first and second inset line, the first and second inset lines being at an angle to each other, the first inset line being a specified distance from a first tangent line, said first tangent line being tangent to said first edge, said second inset line being a specified distance from a second tangent line, said second tangent line being tangent to said second edge; determining a first offset distance from the first edge at which the intersection should be located, determining a second offset distance from the second edge at which the intersection should be located; positioning said planar workpiece adjacent said etcher; transmitting image data and orientation data to said etcher; finding the first edge of said planar workpiece; finding the second edge of said planar workpiece; positioning said etcher adjacent the intersection including positioning said etcher at a point along said first dimension, at a distance from the first edge equal to the first offset distance; positioning said etcher at a point along said second dimension, at a distance from the second edge equal to the second offset distance; and imparting the indicia to the planar workpiece surface at the intersection, wherein the step of imparting the indicia comprises the steps of placing a laser emitting device adjacent the planar surface and emitting light from the laser in a pattern to impart the indicia image and wherein the step of emitting light from the laser in a pattern to impart the indicia is effected using a picture-imparting laser.

Note that although DeRosset does not explicitly recite the step of finding the first edge and second edge of the workpiece and determining offset distances, the position of the workpiece (and therefore the edges of the workpiece) and the offset distances must be visually or mechanically determined (detected) in order to place indicia in a desired location on the workpiece. Therefore, the limitations are considered inherent in the method of DeRosset as broadly claimed by applicant.

DeRosset Jr. does not explicitly teach determining a desired indicia location proximate a corner of said workpiece.

However, the admitted prior art teaches that it is known in the art of etching information on window glass to place indicia in the bottom corner of the glass. It would have been obvious to one of ordinary skill in the art at the time of invention to use the etching method and apparatus of DeRosset Jr. to etch the bottom corner of window glass as described in the admitted prior art as DeRosset Jr. teaches

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a method that is particularly well suited to forming images in window glass in a particular location using a laser.

Regarding Claims 16 and 24-27, DeRosset teaches the method of the invention substantially as claimed, but does not teach determining window specification data by testing the workpiece or using the laser to etch window specification information, text information, logo information or NFRC rating information.

However, the admitted prior art teaches that it is known in the art to test window glass to determine window specification data, and to provide window specification information, text information, logo information or NFRC rating information on the surface of the window glass by etching.

Since DeRosset provides a method of etching window glass to provide such information as a barcode, number, decorative design, or the like, it would have been obvious to one of ordinary skill in the art at the time of invention to use the etching method and apparatus of DeRosset Jr. to etch the window glass information as described in the admitted prior art as DeRosset Jr. teaches a method that is particularly well suited to forming images in window glass in a particular location using a laser.

Regarding Claims 18, 21, and 22, DeRosset inherently teaches transmitting orientation data to the laser as the image data provides a properly oriented image. Further, as discussed in the admitted prior art, laser-marking devices are often supplied with software for loading computer files containing image data. It is notoriously old and well known in the computer image art that image software typically provides orientation data for an image in order to provide an image that is properly oriented.

Regarding Claim 23, DeRosset Jr. teaches receiving the workpiece at a fixed position in a workstation. See Figures 9 and 10 for example.

### ***Conclusion***

This is a continued examination of applicant's earlier application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly,

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**THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberts Culbert whose telephone number is (571) 272-1433. The examiner can normally be reached on Monday-Friday (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on (571) 272-1439. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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